

## REMARKS

This reply is submitted pursuant to 35 U.S.C. §132 and 37 C.F.R. §1.111. The Office Action was carefully considered by the undersigned attorney and applicant. Reconsideration of the application is respectfully requested.

### **1. Summary of the Office Action.**

The drawings were objected to.

Claims 1-9 were pending.

Claims 2-4 stand rejected under 35 U.S.C §112, second paragraph.

Claims 1 stands rejected under 35 U.S.C §102(b) over Tooker (US Patent No. 5,250,318).

Claims 2-4 stand rejected under 35 U.S.C §103(a) over Tooker.

Claims 5-9 were withdrawn.

### **2. Discussion.**

Applicant acknowledges the election without traverse. **Claims 5-9 are hereby canceled** as being withdrawn. Applicant reserves the right to file a divisional application or take other action it deems necessary to preserve it's rights with respect to these claims.

### **Drawing Objection**

Applicant has amended claims 1 and 2. It is believed that the amendments and the remarks below clarify the nature of the tool. The tool is shown in Figures 2, 3 and 4 and designated by the numeral "4". It is described in the specification, also via numeral "4", particularly at page 3, lines 13-26. Accordingly, applicant respectfully submits that no new or corrected drawings are necessary and that the objection should be withdrawn.

#### **Claim Rejection(s) - 35 USC §112, Second Paragraph**

**Claims 2-4.** These claims were rejected under 35 USC §112, second paragraph. **Claim 2** was amended to provide antecedent basis for the tool. Applicant confirms that the Examiner's assumption that the tool is the same tool as that claimed in parent claim 1 is correct. **Claim 4** was amended to clarify and provide basis for edge. **Claim 3** was amended for clarity. The claims particularly point out and distinctly claim the subject matter which applicant regards as the invention. Withdrawal of the rejection is requested.

#### **Claim Rejection(s) - 35 USC §102-103**

**Claim 1.** This claim was rejected under 35 USC §102(b) as being anticipated by Tooker, and under 35 USC 103(a) as being obvious over Tooker. Applicant has amended claim 1 to clarify applicant's method and to patentably distinguish from Tooker. Amended claim 1 now requires that the method utilize a band edge lifting tool which is separate and distinct from the book or book-like article. The tool is part of the gluing machine or associated with it. The claim specifically requires the step of removing the bundle from the tool at the end of the method. In contrast, Tooker discloses a conventional side nipping process that bends both an outer cover 140 and an inner crepe

120. The outer cover does extend beyond the crepe and the nipping block, but it is incorporated into the bound article. It is not and cannot be removed. Applicant's invention provides significant advantages over Tooker in that, as is described in the Specification, the method can be used to make a wide variety of covers including patterned, figured, and other finishes with a variety of bands such as gauze or plastic and for both hard and soft cover applications. Tooker does not disclose or provide such benefits. Applicant respectfully submits that but for the unobviousness of his method, other workers would have been motivated to seek these advantages in the prior art.

Amended claim 1 is believed to be patentable and withdrawal of the rejections is requested.

**Claim 2.** This dependent claim stands rejected under 35 USC 103(a) over Tooker. The claim requires that the sheet-like tool be constructed of a bendable, shape retaining material. This structure and function is not shown or suggested in Tooker which, in contrast, shows a rigid cover material 140 which once bent will not spring back to it's original flat shape. Applicant's invention has the advantage of providing a reusable, repeatable, economical method. The claim is believed to be patentable for this reason in addition to those urged with respect to its base claim 1 (amended) above.

**Claim 10.** This new claim incorporates all of the limitations of amended claims 1 and 2, in a more traditional US claim format. For the reasons discussed above with respect to claims 1 and 2, new claim 10 is believed to be patentable.

**Remaining Claims.** The remaining dependent claims each adds at least one limitation to the elements of its base claim, and is therefore deemed to be allowable with such base and any intervening claim, at least for this reason.

**3. Conclusion.**

The pending claims are believed to be patentable for the reasons stated above. The amendments are believed to be supported by the specification, claims and drawings as filed. It is believed that this case is in a condition for allowance. Reconsideration and favorable action are respectfully requested.

**Should the Examiner believe that telephone communication would advance the prosecution of this case to finality, he is invited to call at the number below.**

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time under 37 CFR 1.136(a), provided a Petition is not submitted separately.

Please charge any fee due not paid by a check or credit card provided herewith, and/or charge any underpayment in any fee, and/or credit any overpayment in fee, to Deposit Account No. 19-2381.